

REMARKS

Claims 1-39 are pending in the application. Claims 40-61 are withdrawn. In this response, claims 1, 7 and 11 are amended and claims 4-6 and 8-9 are canceled. No new matter is believed to be added by this amendment as all claim amendments are supported by the specification. Applicant submits that all of the claims are now in a form for allowance.

Claim Rejections – 35 U.S.C. § 102

In the Office Action, claims 1, 3 and 8 were rejected under 35 U.S.C. 102(e) as allegedly being anticipated by Ellis at al. (US Patent No. 6,275,268) (“Ellis”).

A proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). The test is the same for a process. Anticipation requires identity between the claimed process and a process of the prior art. The claimed process, including each step thereof, must have been described or embodied, either expressly or inherently, in a single reference. *See, e.g., Glaverbel S.A. v. Northlake Mkt’g & Supp., Inc.*, 45 F.3d 1550, 33 USPQ2d 1496 (Fed. Cir. 1995). Those elements must either be inherent or disclosed expressly. *See, e.g., Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988); *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *See, e.g., Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991). In summary, the single prior art reference must properly disclose, teach or suggest each element of the claimed invention. Moreover, “every element of the claimed invention must be literally present, arranged as in the claim. ... The identical invention must be shown in as complete detail as is contained in the patent claim.” *See, e.g., Richardson v. Suzuki Motor Company Co.* 868 F.2d 1226, 1236 (Fed. Cir. 1989).

As provided above, a claim can be anticipated only if each and every limitation of that claim is found in a single prior art reference. Applicants respectfully submit that Ellis fails to

teach all the limitations of claim 1, as amended. Ellis does not disclose, teach or suggest configurable transactions in a media service system. Specifically, Ellis does not disclose, teach or suggest a plurality of configuration options that are presented to a user by an administrator such that the user can select one or more of the plurality of configuration options that define a transaction process. Further, Ellis does not disclose or teach a plurality of transaction processes comprised of pre-configured transaction processes and user defined transaction processes (at least one user defined transaction process comprises the user selected at least one transaction configuration option) and implementing at least one of the transaction processes responsive to the user indicating a desire to purchase an item or service utilizing the at least one client device.

As such, Applicants respectfully submit that claim 1 is not anticipated by Ellis, and is in a form for allowance. Similarly, as claim 3 depends from allowable independent claim 1, Applicants submit that this claim is also in a form for allowance. See *In re Fine*, 5 U.S.P.Q.2d 1569, 1600 (Fed. Cir. 1988) (“Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious.”). Using this same rationale, dependent claims cannot be anticipated if the independent claims from which they depend are not anticipated. Applicants request to cancel claim 8, without prejudice. Applicants submit that claims 1 and 3 are in a form for allowance.

Claim Rejections – 35 U.S.C. § 103

Claims 4-7 and 9-39 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Ellis in view of Official Notice. Specifically the Examiner has taken Official Notice that “it is old and well known in the art for an administrator to access an administrator to access a system under his or her control,” and that “it is old and well known in the art to require a correct PIN to complete a transaction.” (See Office Action, Page 4).

Applicants respectfully request to cancel claims 4-6 and claim 9.

Applicants first submit that, for a *prima facie* case of obviousness, the cited prior art references (when combined) “must teach or suggest all the claim limitations” MPEP § 2143. Thus, if the combination of references does not teach each of the claimed limitations, a finding of

obviousness fails. In addition, the Patent Office has the burden under § 103 to establish a *prima facie* case of obviousness, which can be satisfied only by showing some objective teaching in the prior art would lead one to combine the relevant teachings of the references. *See In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). As such, an Applicant, to overcome an allegation of obviousness, can show that the cited prior art references (when combined) do not teach or suggest all the claim limitations or that there is not an objective teaching in the prior art that would lead one to combine the relevant teachings of the references.

Applicants respectfully submit that a *prima facie* case of obviousness is not established using the art of record.

1. Claims 7 and 10-39

Claims 7 and 10-39 are dependent claims that depend either directly or indirectly from claim 1. These claims have each been rejected in the Office Action as allegedly being obvious over Ellis in view of Official Notice.

As indicated above, Ellis fails to teach, suggest or make obvious to one of ordinary skill in the art configurable transaction processes in a media service system. Specifically, as claims 7 and 10-39 incorporate all limitations of their base claim (claim 1) and any intervening claims, Ellis does not disclose, teach, suggest or make obvious a plurality of configuration options that are presented to a user by an administrator such that the user can select one or more of the plurality of configuration options that define a transaction process. Further, Ellis does not disclose, teach, suggest or make obvious a plurality of transaction processes comprised of pre-configured transaction processes and user defined transaction processes (at least one user defined transaction process comprises the user selected at least one transaction configuration option) and implementing at least one of the transaction processes responsive to the user indicating a desire to purchase an item or service utilizing the at least one client device. The Official Notice taken by the Examiner that “it is old and well known in the art for an administrator to access an administrator to access a system under his or her control,” and that “it is old and well known in the art to require a correct PIN to complete a transaction” fails to correct the deficiencies of Ellis.

Therefore, as the Official Notice fails to correct the deficiencies of Ellis, Ellis and the Official Notice, alone or in combination, fail to teach suggest or make obvious all of the

limitations of claims 7 and 10-39 as these claims now depend from an allowable base claim and as such are allowable as a matter of law. As the Court noted in *In re Fine*, “dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious.” 5 U.S.P.Q.2d 1569, 1600 (Fed. Cir. 1988). Therefore, Applicants respectfully submit that because independent claim 1 is not obvious (or anticipated) over Ellis or Ellis in combination with the Official Notice, claims 7 and 10-39 are also nonobvious and in a form for allowance.

Second, the Supreme Court has reaffirmed the *Graham* factors for determination of obvious under 35 U.S.C. 103(a). *KSR Int’l Co. v. Teleflex, Inc.* (KSR), No 04-1350 (U.S. Apr. 30, 2007). The four factual inquiries under *Graham* require examination of: (1) the scope and contents of the prior art; (2) the differences between the prior art and the claims in issue; (3) the level of ordinary skill in the pertinent art; and (4) the objective evidence of secondary consideration. *Graham v. John Deere (Graham)*, 383 U.S. 1, 17-18, 149 USPQ 459, 467 (1966); see also 35 U.S.C. § 103 (2000).

The Court has further recognized that the requirement for a teaching, suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, which was established by the Court of Customs and Patent Appeals, provides a helpful insight for determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a).

Where an invention is contended to be obvious based upon a combination of elements across different references, one should be able to identify particular reasons that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements. *See, KSR Int’l Co.*, at 14, 15. This requirement prevents the use of “the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.” *Ecolochem, Inc. v. So. Cal. Edison Co.*, 227 F.3d 1361, 1371-72 (Fed. Cir. 2000) (quoting *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999)).

Applicants submit that the current construction of the cited references in the manner provided in the Office Action requires hindsight reasoning, which the Federal Circuit has explicitly rejected. *See In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). It would not have been obvious to one of ordinary skill in the art to combine Ellis in view of the

Official Notice. In particular Ellis in view of the Official Notice taken by the Examiner fail to teach, suggest or make obvious a plurality of configuration options that are presented to a user by an administrator such that the user can select one or more of the plurality of configuration options that define a transaction process. Further, Ellis does not disclose or teach a plurality of transaction processes comprised of pre-configured transaction processes and user defined transaction processes (at least one user defined transaction process comprises the user selected at least one transaction configuration option) and implementing at least one of the transaction processes responsive to the user indicating a desire to purchase an item or service utilizing the at least one client device. Applicants earnestly request reconsideration, withdrawal of these rejections, and allowance of claims 7 and 10-39.

Traverse of Official Notice Taken by the Examiner

The Office Action provides that Official Notice is taken in regard to claims 4-7 and 9-39 that "it is old and well known in the art for an administrator to access an administrator to access a system under his or her control," and that "it is old and well known in the art to require a correct PIN to complete a transaction." (See Office Action, Page 4).

In accordance with MPEP 2144.03, Applicants hereby traverse these assertions of common knowledge or official notice unsupported by documentary evidence. MPEP 2144.03 provides in part:

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. See also *In re Grose*, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979) ("[W]hen the PTO seeks to rely upon a chemical theory, in establishing a prima facie case of obviousness, it must provide evidentiary support for the existence and meaning of that theory."); *In re Eynde*, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973) ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice."). (Emphasis added in bold.)

In accordance with the requirements of MPEP 2144.03 for traversing the use of Official Notice to formulate obviousness-based rejections, Applicant hereby specifically points out the supposed errors in the examiner's action, which includes stating why the noticed fact is not considered to be common knowledge or well-known in the art. In each of the above claimed instances, the technology involved a method in a media service system for transaction configuration, which in the context as claimed and supported by the specification is an area of esoteric technology and, as such, the statements of common knowledge or official notice by the examiner are “assertions of technical facts in the areas of esoteric technology” that “must always be supported by citation to some reference work recognized as standard in the pertinent art.” (MPEP 2144.03). Applicants therefore request cancellation of the rejections based on Official Notice unsupported by documentary evidence or, alternatively, providing documentary evidence of the assertions made as Official Notice.

Conclusion

Claims 1-39 are pending in the application. Claims 40-61 are withdrawn. In this response, claims 1, 7 and 11 are amended and claims 4-6 and 8-9 are canceled. No new matter is believed to be added by this amendment as all claim amendments are supported by the specification. Of these pending claims, claim 1 is an independent claim. Since the Applicants respectfully assert that this independent claim is allowable, remaining dependent claims 7 and 10-39 are also allowable. Thus, Applicants respectfully request allowance of all the pending claims in view of the subsequent remarks regarding the above-mentioned independent claims.

No fee is believed due beyond the fee for the accompanying Request for Continued Examination (RCE); however, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

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